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In re Application of : DECISION ON
Long et al :
PCT No.: PCT/US99/15129 :
Application No: 10/018,551 : PETITION UNDER
Int. Filing Date: 02 July 1999 :
Priority Date: 02 July 1998 :
Attorney's Docket No.: 047714-5001-US : 37 CFR 1.47(a) &
For: IN VIVO ADDITION OF TELOMERIC ... :
IN THE FUNGUS PESTALOTIOPSIS : 37 CFR 1.137(b)

This is in response to the "PETITION FOR FILING AN APPLICATION UNDER 37 CFR 1.47(a) with accompanying STATEMENT OF FACTS IN SUPPORT THEREOF" and PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) filed on 18 April 2003. The petition fee of 130.00 has been charged to Deposit Account No: 50-0310 as stipulated in the communication on 18 April 2003. The petition under 37 CFR 1.137(b) has already been charged to Deposit Account.

BACKGROUND

On 02 July 1999, applicants filed international application PCT/US99/15129, which claimed priority to an earlier application filed 02 July 1998. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 13 January 2000. A DEMAND was filed on 31 January 2000 prior to the expiration of 19 months from the priority date electing the United States. Accordingly, the thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 02 January 2001.

On 20 December 2001, applicant filed in the United States Patent & Trademark Office (USPTO) petition for revival under 37 CFR 1.137(b) and a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, the U.S. basic national fee. No executed oath or declaration accompanied the above the above papers.

On 13 March 2002, the petition under 37 CRF 1.137(b) was granted, and was returned to the United States Designated/Elected Office for continued processing.

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On 26 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from its 26 March 2002 date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 18 April 2003, petitioner filed the present petitions, a declaration in support of filing on behalf of omitted inventor David M. Long accompanied, *inter alia*, an executed Declaration without the signatures of David M. Long, and a petition under 37 CFR 1.137(b).

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be

permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) - (3) of **37 CFR 1.47(a)**, but requirement (4) has not been satisfied.

Regarding requirement (1), petitioner has provided the fee under **37 CFR 1.17(h)**.

Regarding requirement (2), the averments of Ms. Mahurin are sufficient to support a finding that the nonsigning inventor, Mr. Long refuses to sign because a copy of the patent application papers including the Specification, Claims, Drawings, and a Declaration which was mailed to Mr. Long for his execution on January 8, 2003 and to this date, 07 March 2003, he has not responded. Ms. Mahurin has provided a copy of the cover letter and the registered mail return receipt confirming that Mr. Long received the application papers on January 18, 2001. In addition, Ms. Mahurin telephoned Mr. Long and requested that he sign the combined declaration and Power of Attorney for the above captioned application and he refused.

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventors.

Regarding requirement (4), petitioner has provided a defective executed composite declaration signed by Mr. Smidansky and Mr. Strobel. The composite declaration is defective because it comprises of two sets of declarations since two separately executed signature pages have been submitted each signed by one inventor out of the three. The composite declaration under 37 CFR 1.497(a) and (b) requires that the declaration must be complete and identify each inventor. In this case only, one set is complete because it comprises of the three (3) pages of the declaration. The second set of the composite executed declaration only contains the signature page.

Petitioner has not satisfied item (4) under 37 CFR 1.47(a), thus not completing the requirements under 37 CFR 1.47(a).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

PETITION UNDER 37 CFR 1.137(b):

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting an executed declaration, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Petitioner has not provided requirement (1), because the proper reply of a proper executed declaration has not been submitted.

Accordingly, the petition is not deemed to satisfy requirement (4) under 37 CFR 1.137(b).

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petitions under 37 CFR 1.47(a) and 1.137(b) are desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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